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USSN: 10/066,518

REMARKS

In view of the following remarks, the Examiner is requested to allow claims 1-10, 13-19, and 44-46, the only claims pending and under examination in this application.

Information Disclosure Statement

Applicants note that an Information Disclosure Statement (IDS), including an SB/08A form, was submitted in this application on April 13, 2005. The Applicants respectfully request that the Examiner initial and return this SB/08A form, thereby indicating that the references cited in the IDS have been reviewed and made of record. For the Examiners convenience, a copy of this form is enclosed herewith.

Claim Rejections – 35 U.S.C. § 102

Claims 1-10, 13, 18, 19, and 44-46 were rejected under 35 U.S.C. §§ 102(a) and 102(e) as allegedly being anticipated by Kowalis et al. (U.S. Patent 6,228,659). This rejection is respectfully traversed.

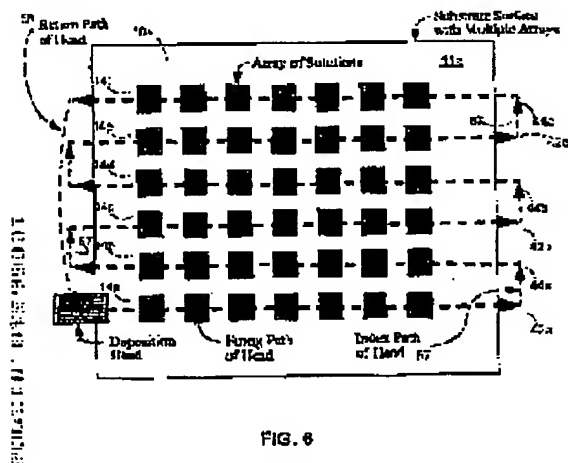
A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In response to Applicants earlier argument that Kowalis et al. does not disclose displacement of the dispensing head in a sideways orientation between one array set, the Examiner responded that Kowalis et al. "clearly" teaches sideways displacement of the dispenser. Office Action at page 5. She has relied on Figures 5 and 6 of Kowalis et al. to support her position. Applicants respectfully disagree.

The arrows in Figure 6 of Kowalis et al. indicate that the dispensing head assembly is moved back and forth in opposite directions across the substrate. See also the paragraph bridging Columns 5 and 6 of Kowalis et al. Movement in a sideways direction requires that the assembly turn 90° between one array set and another. See the arrows marked 57 in Applicants' Figure 6. Kowalis et al. deposits

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reagents first from one row of heads, then from two rows of heads, then from three rows of heads, and so on, while moving the head assembly back and forth in opposite directions across the substrate. See also Figure 7 of Kowalis et al. This procedure does not employ or rely upon sideways displacement of the dispensing head. Applicants' Figure 6 and Figures 6 and 7 of Kowalis et al. are reproduced below to facilitate the appreciation of Applicants' arguments.

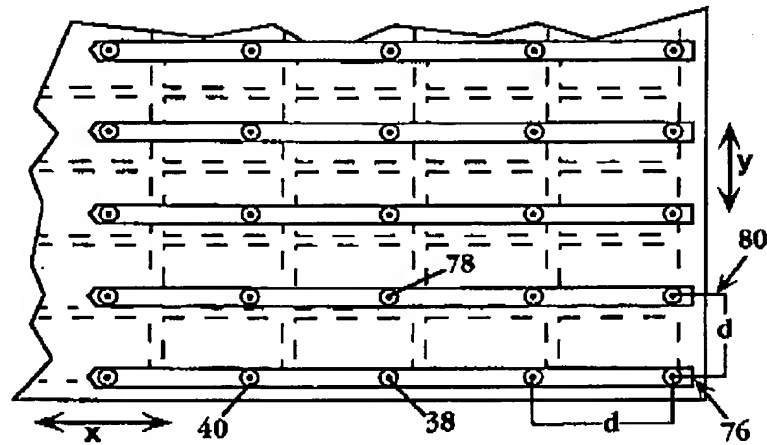
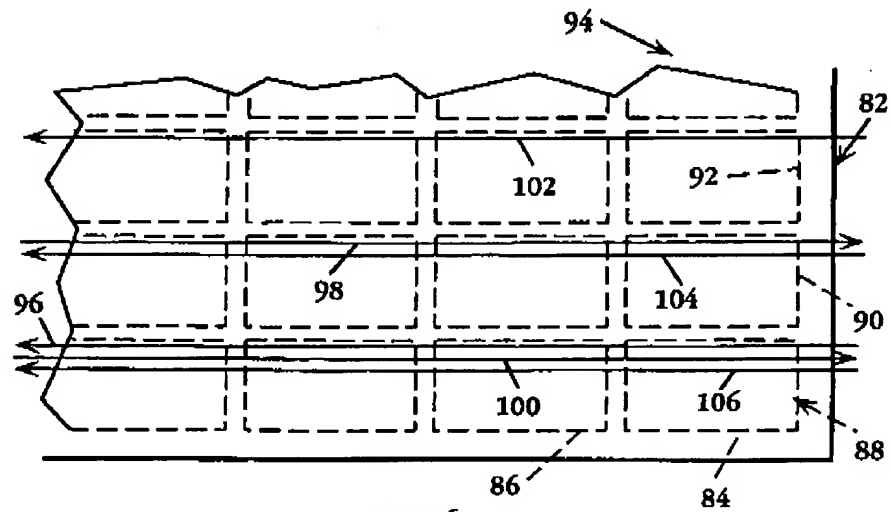


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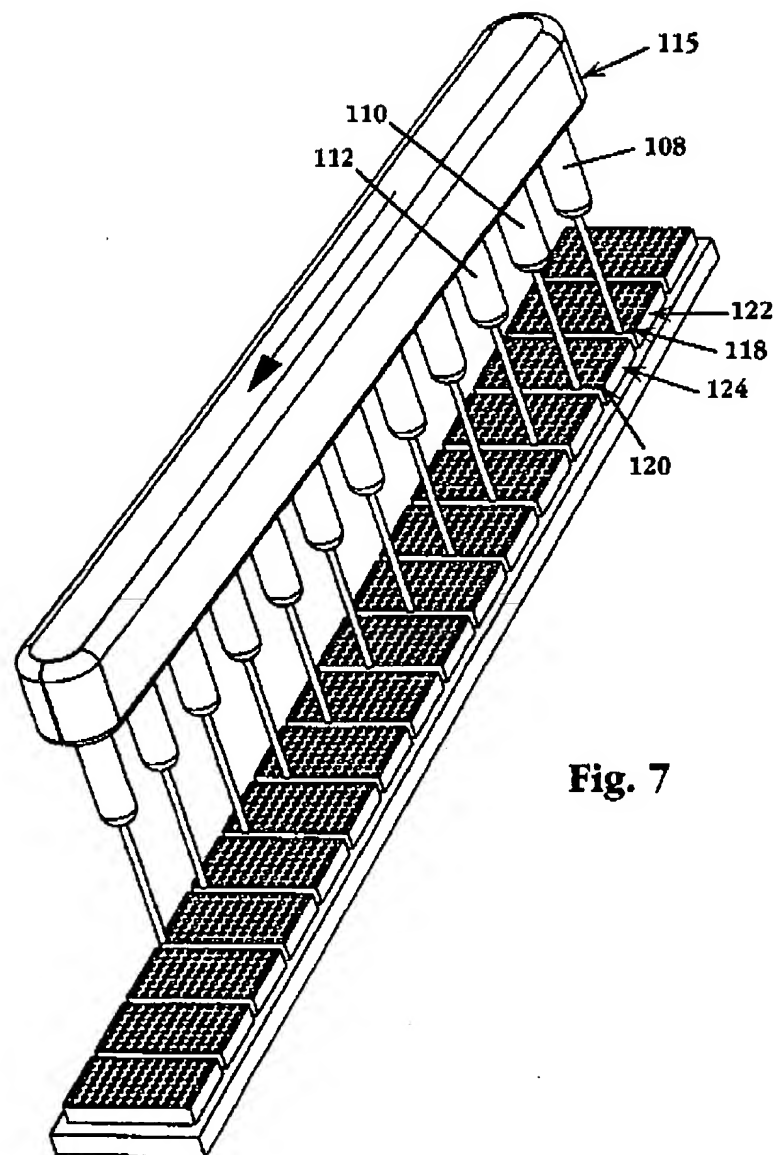
US 6,228,659 B1**Fig. 5****Fig. 6**

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US 6,228,659 B1**Fig. 7**

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Therefore, Kowalis et al. does not teach each and every element of Applicants' claims because Kowalis et al. does not disclose displacement of the dispensing head in a sideways orientation between one array set and the next between movements in the opposite directions. As such, there is no anticipation. This rejection may be withdrawn.

Claim Rejections – 35 U.S.C. § 103(a)

Claim 16 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kowalis et al., *supra*, in view of Gordon et al. (U.S. Patent No. 5,486,452). This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation either in the cited references themselves or in the knowledge generally available to an art worker, to modify the reference or to combine reference teachings so as to arrive at the claimed method. Second, the art must provide a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations (MPEP § 2143). The teaching or suggestion to arrive at the claimed method and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure (MPEP § 2143 citing with favor, *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)).

Gordon et al. was cited for a teaching of array separation. Accordingly, Gordon et al. does not remedy the deficiency in Kowalis et al., noted above in the response to the rejection under 35 U.S.C. § 102. Therefore, for at least the reason that the combination of documents does not teach or suggest all of the elements of Applicants' claims, there is no *prima facie* obviousness. This rejection may be withdrawn.

Claim 17 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kowalis et al., *supra*, in view of Zeleny et al. (U.S. Patent No. 6,215,894). This rejection is respectfully traversed.

Zeleny et al. was cited for a teaching of array identifiers. Accordingly, Zeleny et al. does not remedy the deficiency in Kowalis et al., noted above in the response

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to the rejection under 35 U.S.C. § 102. Therefore, for at least the reason that the combination of documents does not teach or suggest all of the elements of Applicants' claims, there is no *prima facie* obviousness. This rejection may be withdrawn.

Allowable Subject Matter

Applicants acknowledge with appreciation the indicated allowability of Claims 14 and 15.

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CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 833-7770.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10010469-1.

Respectfully submitted,

Date: May 3, 2006

By:



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Date: May 3, 2006

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